



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,116	08/31/2001	Jiandong Shen	CISCP193/3930	2081
22434	7590	12/13/2006	EXAMINER	
BEYER WEAVER & THOMAS, LLP			SENF, BEHROOZ M	
P.O. BOX 70250			ART UNIT	
OAKLAND, CA 94612-0250			PAPER NUMBER	

2621

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/945,116

Applicant(s)

SHEN ET AL.

Examiner

Behrooz Senfi

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-22 and 40-43 is/are allowed.
- 6) ☒ Claim(s) 23-39 and 44-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Based on a Pre-Brief Appeal Conference decision; dated 09/21/2006, the rejection is withdrawn.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 23 – 39 and 44 - 46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 44 and 45, it is noted that, the claim invention is directed to a system for providing video data, comprising “means for receiving a compressed bit-stream containing the video data and a residual error vector index; means for converting the error vector index to an error vector, the residual error vector comprising an array of predetermined motion compensation errors; means for decoding a portion of the video data into an uncompressed format using the residual error vector; and means for outputting the video data in the uncompressed format”. However, as stated in the specification; page 22, lines 3 – 14, such system may be a software program; therefore such process claim does not result to a practical application which produces a “useful, concrete and tangible result”, as required in the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (Official Gazette Notice of 22 November 2005).

Regarding claim 46, it is noted that, the claim invention is directed to a computer readable medium including instructions for decoding video data, comprising a plurality

of instructions. However such computer claim does not fall within the statutory classes as set forth in Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (Official Gazette Notice of 22 November 2005). Furthermore; in the specification of the instant application, page 24, lines 24 – 27, consider machine-readable media as a carrier wave/signal. Therefore such carrier does not result to a practical application, which produces a “useful, concrete and tangible result”, as required in the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (Official Gazette Notice of 22 November 2005).

Claims 23 is rejected for the similar reason as set forth in claim 45 above.

Regarding claim 34, it is noted that, the claim invention is directed to a residual error codebook for use in encoding and decoding video data; comprising a set of residual error vector and a residual error vector index associated with each residual error vector, each residual error vector in the set of residual error vectors comprising an array of predetermined motion compensation errors. However, such claim invention does not result in a practical application, which produces a “useful, concrete and tangible result”, as required in the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (Official Gazette Notice of 22 November 2005). Since claims 24 – 33 and 35 - 39 depend from independent claims 23 and 34, claims 23 – 39 as a whole do not fall within the statutory classes under 35 U.S.C. 101.

Allowable Subject Matter

4. Claims 1 – 22 and 40 – 43 are allowed over the prior art of the record.

5. The following is an examiner's statement of reasons for allowance: the prior art of the record fails to anticipate or rendered obvious the limitation "a system for providing video data, the system comprising: a decoder apparatus configured to receive a bit-stream comprising compressed video data and a residual error vector index, and configured to output the video data in an uncompressed format; and a residual error codebook comprising a set of residual error vectors and a residual error vector index associated with each residual error vector, each residual error vector in the set of residual error vectors comprising an array of predetermined motion compensation errors" as claimed.

Claims 2 – 6, 8 – 13, 15 – 22 and 41 – 43 depend from independent claims 1, 7, 14 and 40, and therefore are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Contact

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Behrooz Senfi** whose telephone number is **(571) 272-7339**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mehrdad Dastouri** can be reached on **(571) 272-7418**.

Hand-delivered responses should be brought to Randolph Building, 401 Dulany Street, Alexandria, Va. 22314.

Any inquiry of a general nature or relative to the status of the application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is **(571) 272-6000**,

Or faxed to:

(571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B.M.S.



TUNG VO
PRIMARY EXAMINER